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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,475	02/21/2001	Jerre Wayne Mohler	FWS-3667	6204

7590

04/09/2003

E. Philip Koltos  
Division of General Law Office of the Solicitor  
U.S. Department of the Interior  
1849 C Street NW,  
Washington, DC 20240

EXAMINER

MORAN, TIMOTHY J

ART UNIT

PAPER NUMBER

2878

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/788,475

Applicant(s)

MOHLER, JERRE WAYNE

Examiner

Timothy J. Moran

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 4 is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 5-10 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

Claim 3 is objected to because of the following informalities: The term "thought" in line 9 should be replaced with --through--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 5, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the long pass filter" in line 11. There is insufficient antecedent basis for this limitation in the claim since the terms "long pass" and "longpass" are not equivalent. Note also that the term "a barrier or longpass filter" in line 8 implies that a longpass filter may not be present. Note also that the term "between a line of sight and the long pass filter" in lines 10-11 is unclear since it implies that the

Art Unit: 2878

long pass filter is separated from the line of sight, while the figures show that the filter (8) is along the line of sight.

Claim 5 recites the limitation "longpass barrier filter" in line 2. There is insufficient antecedent basis for this limitation in either claim or claim 3.

Claim 10 recites the limitation "the barrier filter" in lines 1-2. There is insufficient antecedent basis for this limitation in this claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Coates, U. S. Patent No. 4,884,890. Regarding claim 1, Coates describes a device (fig. 1) for detecting visible fluorescence comprising a light source (10), an exciter filter (14), a dichroic beamsplitter (16, col. 2, lines 27-35), a barrier filter (24) and an achromatic lens (24). Here the term "achromatic lens" is understood to mean "a lens which transmit light of various wavelengths equally well." Note that the term "between a line of sight and the long pass filter" is has not been addressed.

Regarding claim 2, Coates describes the use of a mercury lamp (col. 2, lines 27-35).

Regarding claim 6, Coates describes a method for examining a sample comprising contacting a sample with light transmitted through a dichroic beamsplitter

(16, col. 2, lines 27-35), and observing light emitted from the sample through the beamsplitter (fig. 1). Regarding the term "fluorochrome," the description of the sample as "fluorescent" (see abstract) is understood to imply that the sample comprises a fluorochrome.

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Metz, U. S. Patent No. 5,166,813. Metz describes a method for examining a sample comprising contacting a sample with light transmitted through a dichroic beamsplitter (14, col. 9, lines 45-53), and observing light emitted from the sample through the beamsplitter (fig. 1). Regarding the term "fluorochrome," the description of the sample as "fluorescent" (see abstract) is understood to imply that the sample comprises a fluorochrome.

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Neel, U. S. Patent No. 5,639,668. Neel describes a method for examining a sample comprising contacting a sample with light transmitted through a dichroic beamsplitter (38, col. 9, lines 39-40), and observing light emitted from the sample through the beamsplitter (fig. 1). Regarding the term "fluorochrome," the description of the sample as "fluorescent" (see abstract) is understood to imply that the sample comprises a fluorochrome.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2878

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neel as applied to claim 6 above, and further in view of Chu, U. S. Patent No. 5,440,927. Chu describes a method for examining a sample to detect fluorescence where calcein (col. 4, lines 13-30) is used as a fluorochrome to enable moisture detection. Therefore it would have been obvious to one of ordinary skill in the art to use calcein in the method of Neel to enable moisture detection.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neel as applied to claim 6 above, and further in view of Eckstrom, U. S. Patent No. 5,324,940. Neel teaches a method for examining a biological sample, but does not teach that the method is applied to live animals or salmon. However, Eckstrom teaches that fluorescence detection of live fish is useful for identification purposes. Therefore, it would have been obvious to one of ordinary skill in the art to use the detection method of Neel to analyze live animals such as salmon for the advantages of accurate identification.

#### ***Allowable Subject Matter***

Claims 3-4 are allowed.

Claims 5 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claim 3 includes the limitations that a fluorescence detection device comprises a light guide, an excitation or bandpass filter, a dichroic beamsplitter, and a separate

Art Unit: 2878

longpass or barrier filter. Claim 10 includes the limitations that a barrier filter located in eyeglasses is used with a beamsplitter to analyze a live animal specimen.

**Conclusion**

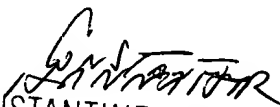
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Moran whose telephone number is 703-305-0849. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on 703-308-4852. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

T.M.

TM  
April 1, 2003

  
CONSTANTINE HANNAHER  
PRIMARY EXAMINER  
GROUP ART UNIT 2878